



UNITED STATES PATENT AND TRADEMARK OFFICE

cm

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,077	10/07/2003	David Hodess	562072000300	6231

7590

01/13/2005

David T. Yang
Morrison & Foerster LLP
35th Floor
555 W. 5th Street
Los Angeles, CA 90013

EXAMINER

BUI, LUAN KIM

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/681,077

Applicant(s)

HODESS ET AL.

Examiner

Luan K Bui

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Makofsky et al. (6,564,994; hereinafter Makofsky'994) in view of Panveno (4,339,034) and Brody (2,777,574). Makofsky'994 discloses a system for transporting CD holder/disc (column 1 and column 3) comprising a CD holder which is considered equivalent to an inner pocket as claimed and an envelope (44) having an opening into which the holder/inner pocket can be inserted. The envelope including a sealing portion (16) for sealing the envelope and the sealing portion having a detachable portion (35) and a reseal portion (30). The envelope can be unsealed by detaching the detachable portion of the sealing portion and the envelope can be resealed using the reseal portion of the sealing portion after the detachable portion of the sealing portion is detached. To the extent that Makofsky'994 fails to show the CD holder comprises an inner pocket having an opening, Panveno teaches a system for transporting media comprising an inner pocket (14) having an opening for receiving a media, a foldable jacket (18) adapted to receive the inner pocket and an envelope (12) made of a cardboard material having an opening (24) into which the foldable jacket can be inserted (Figure 1). Brody shows a system for transporting media comprising an inner pocket (16) having an opening for receiving a media, a foldable jacket (14) formed from a stiff cardboard sheath adapted to receive the inner pocket and an envelope (3) having an opening (10) into which the foldable jacket can be inserted. Brody

Art Unit: 3728

further shows the inner pocket (16) may be made of cardboard, plastic sheet or other suitable material and is preferably smooth or polished nature so it will not damage the media. It would have been obvious to one having ordinary skill in the art in view of Panveno and Brody to modify the system of Makofsky'994 so the CD holder comprises an inner pocket having an opening into which a digital media can be inserted for further protecting the media.

As to claims 3, 5 and 6, the system of Makofsky'994 as modified fails to show the material of the inner pocket, the jacket or the envelope as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Makofsky'994 as modified so the envelope, inner pocket and the jacket are made from the material as claimed for better protecting the media and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

3. Claims 8 and 9-13 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Colangelo (4,473,153).

Makofsky'994 fails to show the reseal portion of the sealing portion being coated with an adhesive. Colangelo teaches a system for transporting media comprising an envelope (2) having an opening for receiving a media and a foldable flap (6) having an adhesive (40) for sealing the media. It would have been obvious to one having ordinary skill in the art in view of Colangelo to modify the sealing portion Makofsky'994 as modified so the reseal portion comprises an adhesive in lieu of Velcro elements (50, 51) for better securing the sealing portion to the

Art Unit: 3728

envelope. As to claim 9, Makofsky'994 as modified further fails to show the foldable jacket includes a non-abrasive texture. Colangelo further teaches the media is enclosed in a plastic jacket having a non-abrasive liner (column 1, lines 14-16). It would have been obvious to one having ordinary skill in the art in view of Colangelo to modify the foldable jacket of Makofsky'994 as modified so the foldable jacket includes a non-abrasive texture to prevent the media being damaged by abrasion.

Response to Arguments

Applicant's arguments with respect to 12/6/2004 have been considered but are deemed to be moot in view of the new grounds of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3728

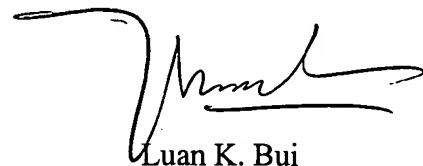
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (571) 272-4552. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Ms. Merilyn Watts at (571) 272-4398.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service whose telephone number is (703) 306-5648. Facsimile correspondence for this application should be sent to (703) 872-9306 for Formal papers and After Final communications.

lkb
January 9, 2005

A handwritten signature in dark ink, appearing to read 'Luan K. Bui', with a long horizontal flourish extending to the right.

Luan K. Bui
Primary Examiner